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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,203	03/10/2004	Phil Stewart	420624	4179

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LATHROP & GAGE LLP
2345 GRAND Boulevard
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EXAMINER

CHAPMAN, JEANETTE E

ART UNIT	PAPER NUMBER
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3633

NOTIFICATION DATE	DELIVERY MODE
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08/05/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@lathropgage.com

Office Action Summary	Application No. 10/797,203	Applicant(s) STEWART, PHIL	
	Examiner Jeanette E. Chapman	Art Unit 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-44 is/are pending in the application.
- 4a) Of the above claim(s) 21-33 and 36-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-20,34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on 5/19/09 is acknowledged. The traversal is on the ground(s) that there is not more than one invention and that the search would not be burdensome. This is not found persuasive because the examiner must still provide a search for the method limitations such as the positioning step .

The requirement is still deemed proper and is therefore made FINAL.

Applicant elected Group I, claims 1-2, 5-20 and 34-35. Claim 21-33, 36-44 directed to group II have been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5-11, 16, 19-20, 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable Hohn (4454181) in view of Barrett (4406099) and Clary (3271787).

Hohn discloses a form or molded article 3 configured for fitting over a surface of an existing tile 2. The article or decorative cap 3 includes:

- A first surface 5
- A second surface 6/8, oppositely disposed from each other

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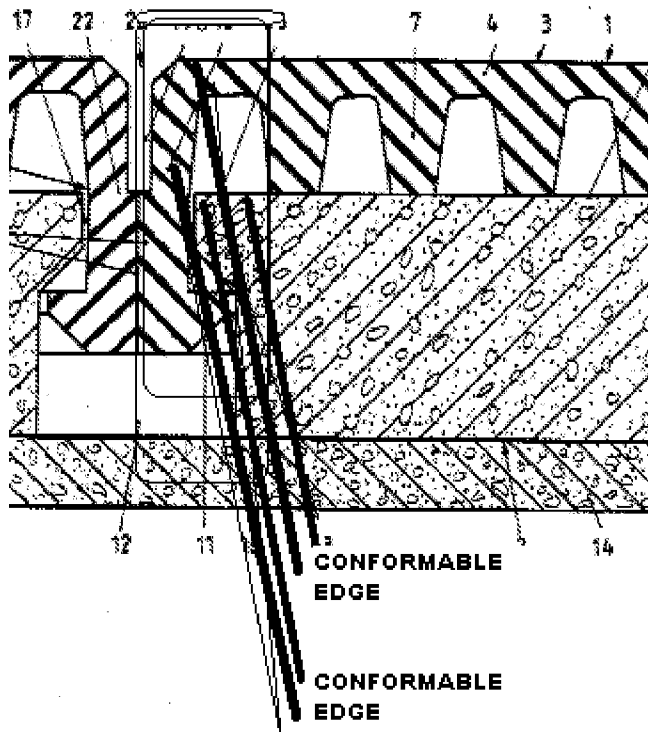
- At least one edge extending from the body and the first and the second surface and including at least one edge defined by the convergence of the second surface toward the first at 11
- At least one edge at 10 and 11 configured for being adjusted for the body to lie over the surface of an existing tile conforming to the edge of the existing tile and for conforming with the surface along a corresponding edge of an existing tile; see annotations on patent copy below
- At least one edge extending from the body
- The at least one edge configured for conforming with a corresponding edge of the tile 10; and the edge capable of being trimmed by a knife in conformance with a corresponding edge along the surface of the existing tile
- Hohn lacks a mastic adhesive in communication with the second surface. Barrett discloses a tile covering 16 backed with adhesive. It would have been obvious to one of ordinary skill in the art to apply adhesive to the back surface of the covering of Hohn to prevent temporary dislodgement. It would have been obvious to employ any adhesive known in the art capable of fulfilling the purpose and function of the application of such adhesive.
- The molded article is selected from the group consisting of a plastic article; see abstract
- Hohn discloses the tile of wood, concrete, plastic or the like. The material of the tile has been considered immaterial since applicant is not positively claiming the tile and especially not claiming the combination of the tile and the tile cap; further

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Clary leaves the possibility of the types of materials open to the particular tile of use. One of ordinary skill in the art would have selected any material known in the art and suitably combined with the tile cap of Hohn. Such a selection is well within the scope of Hohn .

- The tile is applied to a surface grout
- The tile cap has a trimmable knife edge adjacent lead line 19; since the material is a compressible rubber the same is obviously trimmable.
- The method steps are met by Hohn as the same provides the above structure
- hohn also shows the tile cap positioned over the existing tile 2
- Adjusting the tile at the at least one edge such that the body lie over the surface of the existing ceramic tile and the Barrett teaches the adhesive will contact the body and the surface of the existing tile and Hohn teaches at least one edge will conform to the corresponding edge of the existing tile

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Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohn in view of Barrett and Clary and further in view of Zinbarg (5946869).

Further, the type of adhesive is obviously not critical to the invention in view of the fact that applicant has claimed every type of adhesive known in the art. Given the lack of criticality and relevancy, one of ordinary skill will have been able to select any adhesive that would function as intended. Nevertheless, Zinbarg discloses a plastic material over a panel employing double sided foam tape. Zinbarg also suggest the use of other known adhesives. See column 4, lines 1-35. It would have been obvious to employ any adhesive suitable for use such as the double sided foam tape which prevents marring of the panel surface.

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Claims 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohn in view of Barrett and Clary and further in view of Stoneburner (3359574). Hohn lacks the molded article with germicidal and bacteriostatic characteristics. Stoneburner discloses a wall panel of fiberglass plastic including "impregating the same with a suitable germicidal agent..... in order to kill bacteria.... " One of ordinary skill in the art would have appreciated adding these materials as a further means of protections to users.

Response to Arguments

Applicant's arguments file 1/23/09 have been considered but are not deemed persuasive

Applicant argues, "Based on this arrangement of the cover with respect to the base, there is not any conformance of the edges, such that the edge of the cover 3 is resting over the edge of the base 3 along the surface of the base 3 in a conforming manner. Accordingly, Hohn '181 does not show or otherwise disclose in the context of the reference, the claimed subject matter". However, with Hohn there is some conformance of the edge of the cover with the edge of the tile or the cover would not fit over the tile. The close fit is not to the same degree as applicant's but the same still discloses the claimed limitations. Hohn discloses a tile cap with an edge that conformably rest over an edge of an existing tile. The teaching of Barrett is not being bodily incorporated into the teaching of Hohn; Barrett was merely cited to show an adhesive on the back surface of a covering to fit over a floor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JEANETTE CHAPMAN/
PRIMARY PATENT EXAMINER
ART UNIT 3633